

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re:	Application No. 10/817,543)	
)	<i>Confirmation No. 2532</i>
Filed:	April 2, 2004)	
)	
Applicant:	John J. MCKILLIP)	This Appellant's Brief on Appeal Under
)	37 C.F.R. § 41.37 was electronically filed
Title:	INTEGRATED FORMS AND METHOD)	on July 21, 2008 using EFS-Web.
	OF MAKING SUCH FORMS)	
)	
Art Unit:	1772)	
)	
Examiner:	Nasser AHMAD)	
)	
)	
Attorney Docket:	7061/82536)	
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Customer No.:	22242)	

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APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

Sir:

Applicant hereby petitions under 37 CFR § 1.136(a) for a two-month extension of time in the above-identified application, up to and including July 21, 2008, to make this reply timely.

This Appeal Brief is filed in accordance with 37 C.F.R. § 41.37.

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Notice of Appeal of March 21, 2008 / Final Decision of the Examiner of September 21, 2007

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I. REAL PARTY IN INTEREST

Malessa Partners, L.L.C. is the assignee of the above-named patent application

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 1-27 are pending. Claims 21 and 25 are allowed. Claims 2 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claims 1, 3-15, 17-20, 22-24, 26 and 27 are finally rejected. Claims 1, 14, 21, 22, 23, 24, and 25 are the pending independent claims.

IV. STATUS OF AMENDMENTS

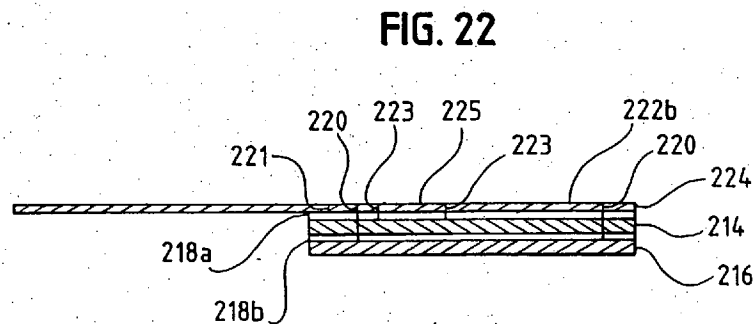
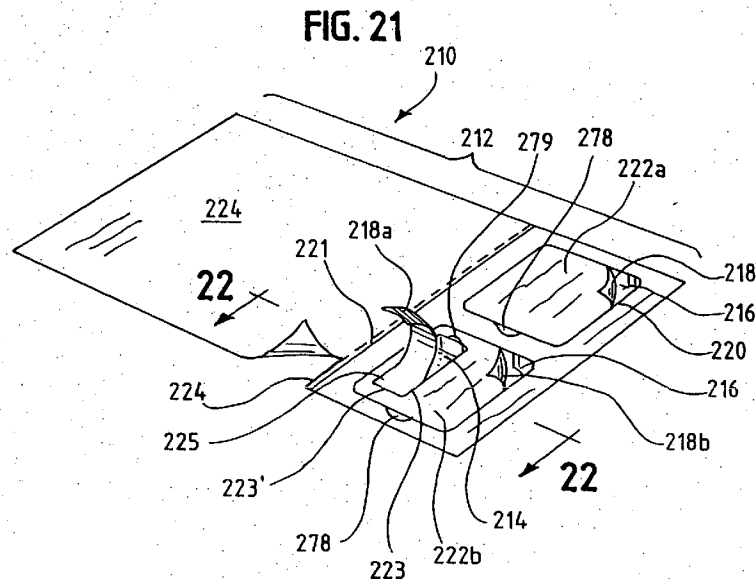
No amendments have been entered after the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Concise Explanation of Subject Matter Defined in the Independent Claims Involved in the Appeal

Referring to FIGS. 21 and 22, which are reproduced below, independent claim 1 defines a business form 210 having a removable integrated portion 222a or 222b. (Specification, ¶ 75, lines 1-5.) The business form 210 includes a base layer 224 having a first side and an opposing second side and a liner layer 214 having a first side and an opposing second side. (*Id.*, ¶ 76, lines 1-5.) The first side of the liner layer 214 is adhesively secured to at least a portion of the second side of the base layer 224. (*Id.*) The business form 210 also includes a backing layer 216 having a first side and an opposing second side. The first side of

the backing layer 216 is adhesively secured to at least a portion of the second side of the liner layer 214. (*Id.*)



Independent claim 1 also defines the business form 210 as including an integrated removable portion 222a or 222b of at least a portion of the base layer 224 and the liner layer 214. (*Id.*, ¶ 78, lines 1-2.) The integrated removable portion 222a or 222b has a periphery edge substantially defined by a first die cut 220 extending substantially through the base layer 224 and the liner layer 214 so that the backing layer 216 maintains the integrated removable portion 222a or 222b in the form 210 against unintentional removal therefrom. (*Id.*, lines 2-6.)

Independent claim 1 also defines the business form 210 as including an integrated tab 225 comprising a portion of the base layer 224 and surrounded on at least three sides by the integrated removable portion 222b. (*Id.*, ¶ 81, lines 1-4.) The tab 225 is at least partially removable from the base layer portion 224 and has a periphery edge substantially defined by a second die cut 223 extending substantially through the base layer 224 so that the liner layer 214 at least partially maintains the tab 225 in the integrated removable portion 222b against unintentional removal from the form 210. (*Id.*)

Independent claims 14 and 24 are similar to independent claim 1, but define a method of making the form 210.

Independent claim 22 is similar to independent claim 1, but further defines at least a portion of the second side of the base layer 224 coextensive with the integrated tab 225 has a greater affinity for retaining adhesive than the first side of the liner layer 214. (*Id.*, ¶ 82, lines 1-7.)

Independent claim 23 is similar to independent claim 1, but defines the integrated tab 225 as being surrounded by the integrated removable portion 222b and also where the tab 225 is partially connected to the integrated removable portion 222b via a hinge 223'. (*Id.*, ¶ 81, lines 1-4.)

B. Map of Independent Claims to Specification and Drawings

Independent Claim No.	Relevant Specification Pages and Line Numbers	Relevant Drawings
1	Specification, ¶ 75, lines 1-5; ¶ 76, lines 1-5; ¶ 78, lines 1-6; ¶ 81, lines 1-4	FIGS. 21 and 22
14	Specification, ¶ 75, lines 1-5; ¶ 76, lines 1-5; ¶ 78, lines 1-6; ¶ 81, lines 1-4	FIGS. 21 and 22
22	Specification, ¶ 75, lines 1-5; ¶ 76, lines 1-5; ¶ 78, lines 1-6; ¶ 81, lines 1-4; ¶ 82, lines 1-7.	FIGS. 21 and 22

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Independent Claim No.	Relevant Specification Pages and Line Numbers	Relevant Drawings
23	Specification, ¶ 75, lines 1-5; ¶ 76, lines 1-5; ¶ 78, lines 1-6; ¶ 81, lines 1-4	FIGS. 21 and 22
24	Specification, ¶ 75, lines 1-5; ¶ 76, lines 1-5; ¶ 78, lines 1-6; ¶ 81, lines 1-4	FIGS. 21 and 22

It should be understood that this summary and map of the independent claims is only intended as a brief summary. Applicant does not represent or intend that the summary and map, or the accompanying references to the drawings and the specification, comprises an exhaustive presentation of the claims. As always, the claims are to be viewed and interpreted within the legal framework for claim construction, which may include the context of the entire specification as a whole.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Were claims 23, 26, and 27 anticipated under 35 U.S.C § 102(e) by US 6,322,655 ("Casagrande")?

B. Were claims 1, 3, 5-6, 13-15, 22-34 anticipated under 35 U.S.C § 102(e) by Casagrande and claim 12 obvious under 35 U.S.C. § 103(a) over Casagrande?

C. Were claims 4, 7-10, and 17-20 obvious under 35 U.S.C. § 103(a) over Casagrande in view of US 5,736,212 ("Fischer")?

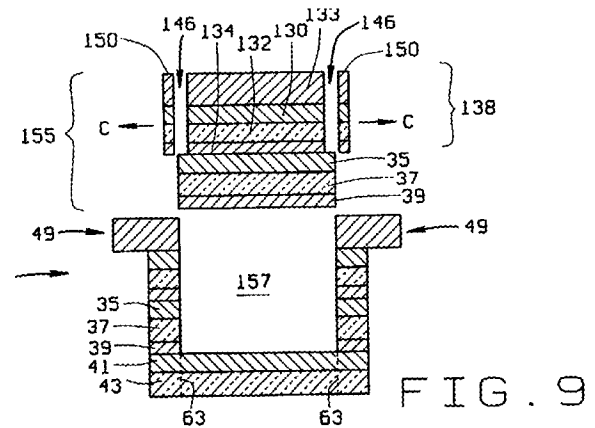
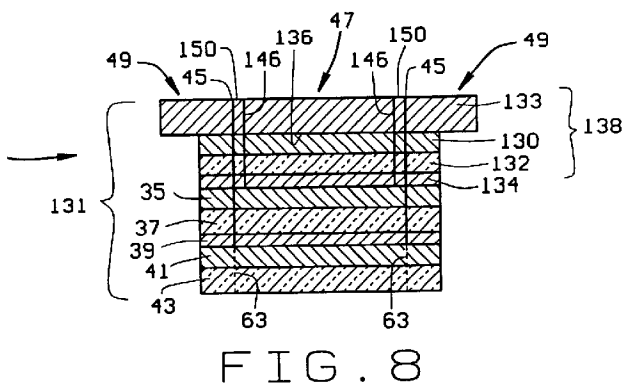
VII. ARGUMENT

A. **Claims 23, 26, and 27 Cannot be Anticipated by Casagrande Because Casagrande Fails to Disclose an Integrated Tab Surrounded by an Integrated Removable Portion**

Section 2131 of the Manual of Patent Examining Procedure states “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Independent claim 23 defines “an integrated tab comprising a portion of the base layer and being surrounded by the integrated removable tab portion.” Dependent claims 26 and 27 depend from independent claims 1 and 14, respectively, and define “the integrated tab . . . completely surrounded by the integral removable portion.” Casagrande cannot anticipate independent claims 23, 26 and 27 because it fails to disclose at least these claim features.

The Office Action suggests that the perimeter portions 150 of Casagrande are the claimed tabs surrounded or completely surrounded by the claimed integrated removable portions. However, as plainly shown in Figures 8 and 9 of Casagrande (reproduced below), the perimeter portions 150 are only bounded by a removable portion on one side by the enclosed shape 47 and, at most, only by two sides by the first multi-ply unit 155 (*i.e.*, layers 35, 37, 39, 130, 132, 133, and 134).

Furthermore, Casagrande, at Column 12, lines 41-43, states that “perimeter portions 150 extending horizontally as shown in FIGS. 8 and 9 between the additional cut 146 and the enclosed shape 47.” Given that the perimeter portions 150 of Casagrande are adjacent to the exterior of the enclosed shape 47 and extend horizontally thereto, it follows that the perimeter portions 150 are not surrounded by the enclosed shape 47. As also illustrated in FIG. 8 of Casagrande, the perimeter portions 150 are adjacent an exterior edge of the enclosed shape 47, and thus cannot be surrounded or completely surrounded by the enclosed shape.



Accordingly, Casagrande cannot anticipate claims 23, 26 and 27 because not all the elements of these claims are disclosed. Applicant respectfully requests withdrawal of the rejection to these claims for at least these reasons.

B. Claims 1, 3, 5-6, 12-15, and 22-34 Cannot be Anticipated by or Obvious Over Casagrande Because Casagrande Fails to Disclose an Integrated Tab Surrounded on at least three sides by an Integrated Removable Portion

Independent claims 1, 14, 22, and 24 all require an integrated tab formed from a portion of the base layer and being surrounded on at least three sides by the integrated removable portion. As discussed above, Section 2131 of the Manual of Patent Examining Procedure requires each and every element to be found in a reference in order to support an anticipation rejection. Casagrande cannot anticipate these independent claims because it fails to disclose at least this claim feature.

As explained above in Section A, Casagrande only shows the perimeter portion 150 (which the Office Action has equated to the claimed integrated tab) as only bounded on one side by the enclosed shape 47 and, at most, only by two sides by the first multi-ply unit 155.

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Accordingly, as plainly shown in FIGS. 8 and 9 of Casagrande included in Section A above, the perimeter portion 150 of Casagrande is not surrounded on at least three sides by the enclosed shape 47 or the first multi-ply unit 155.

Dependent claim 12 is rejected as obvious over Casagrande. However, Casagrande does not disclose all elements of its base claim 1. Therefore, dependent claim 12 cannot be obvious over Casagrande because not all elements of the base claim are disclosed in this reference.

Accordingly, Applicant respectfully requests the withdrawal of the rejections to claims 1, 3, 5-6, 12-15, and 22-34 for at least these reasons.

C. Claims 4, 7-10, and 17-20 Cannot be Obvious Over Casagrande in View of Fischer Because Neither Casagrande nor Fischer Discloses or Suggests an Integrated Tab Surrounded on at Least Three Sides by an Integrated Removable Portion

Claims 4 and 7-10 ultimately depend from independent claim 1, and claims 17-20 ultimately depend from independent claim 14.

As discussed above in Section B, Casagrande does not disclose all limitations of claims 1 and 14 from which these claims depend. As shown in FIG. 2B of Fischer (representative of Fischer's embodiments), which is reproduced below, Fischer only discloses a single card 3 removable from a form sheet 1. Fischer does not disclose or suggest any other integrated tab on the single card 3. Therefore, Fischer also fails to disclose an integrated tab removable from an integrated removable portion where the tab is surrounded on at least three sides.

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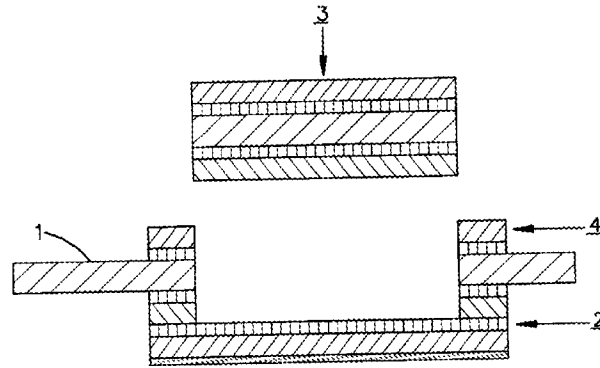


Fig.2b

Accordingly, the combination of Fischer and Casagrande also fails to disclose all elements of the base claims. Applicant respectfully requests the withdrawal of the rejection to dependent claim 4, 7-10, and 17-20 for at least these reasons.

VIII. CLAIMS APPENDIX

Claim 1 (Previously Presented): A business form having a removable integrated portion, the business form comprising:

- a base layer having a first side and an opposing second side;

- a liner layer having a first side and an opposing second side, the first side of the liner layer being adhesively secured to at least a portion of the second side of the base layer;

- a backing layer having a first side and an opposing second side, the first side being adhesively secured to at least a portion of the second side of the liner layer;

- an integrated removable portion of the form comprising at least a portion of the base layer and the liner layer, the integrated removable portion having a periphery edge substantially defined by a first die cut extending substantially through the base and liner layers so that the backing layer maintains the integrated removable portion in the form against unintentional removal from the form; and

- an integrated tab comprising a portion of the base layer and being surrounded on at least three sides by the integrated removable portion, the tab being at least partially removable from the base layer portion and having a periphery edge substantially defined by a second die cut extending substantially through the base layer so that the liner layer at least partially maintains the tab in the integrated removable portion against unintentional removal from the form.

Claim 2 (Original): A business form in accordance with claim 1, wherein the first side of the backing layer has a lesser affinity for retaining adhesive than the second side of the liner layer such that the integrated removable portion comprises a label.

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Claim 3 (Original): A business form in accordance with claim 1, wherein at least a portion of the second side of the base layer coextensive with the integrated tab has a greater affinity for retaining adhesive than the first side of the liner layer.

Claim 4 (Original): A business form in accordance with claim 1, wherein indicia is printed on the first side of the liner layer adjacent the integrated tab such that the indicia is exposed when the tab is at least partially removed from the portion.

Claim 5 (Original): A business form in accordance with claim 1, wherein the second die cut extends along the periphery edge of the tab such that the tab is removable from the portion.

Claim 6 (Original): A business form in accordance with claim 1, wherein the second die cut does not extend completely along the periphery edge of the tab such that the tab is partially connected to the portion.

Claim 7 (Original): A business form in accordance with claim 1, wherein a cut-out extending through the base and liner layers is positioned adjacent the periphery of the card to assist in removal of the portion from the form.

Claim 8 (Original): A business form in accordance with claim 7, wherein the cut-out extends through the base layer.

Claim 9 (Original): A business form in accordance with claim 1, wherein a cut-out extending through the base layer is positioned adjacent the periphery of the tab to assist in removal of the tab from the integrated removable portion of the form.

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Claim 10 (Original): A business form in accordance with claim 1, wherein the cut-out extends through the liner layer.

Claim 11 (Original): A business form in accordance with claim 1, wherein a plurality of portions are provided on the form.

Claim 12 (Original): A business form in accordance with claim 1, wherein a plurality of tabs are provided on the integrated removable portion.

Claim 13 (Original): A business form in accordance with claim 1, wherein indicia is printable on the first side of the base layer.

Claim 14 (Previously Presented): A method of making a business form having a removable integrated portion, the method comprising:

- providing a base layer having a first side and an opposing second side;

- providing a liner layer having a first side and an opposing second side;

- adhesively securing the first side of the liner layer to at least a portion of the second side of the base layer;

- providing a backing layer having a first side and an opposing second side;

- adhesively securing the first side of the backing layer to at least a portion of the second side of the liner layer;

- making a first die cut extending substantially through the base and liner layers to substantially define a periphery edge of an integrated removable portion; and

- making a second die cut extending substantially through the base layer and coextensive with the integral removable portion to substantially define a periphery edge of an integrated tab surrounded on at least three sides by the integral removable portion, the tab being at least partially removable from the integrated removable portion.

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Claim 15 (Original): A method of making a business form in accordance with claim 14, wherein at least a portion of the second side of the base layer coextensive with the integrated tab has a greater affinity for retaining adhesive than the first side of the liner layer.

Claim 16 (Original): A method of making a business form in accordance with claim 14, wherein the first side of the backing layer has a lesser affinity for retaining adhesive than the second side of the liner layer.

Claim 17 (Original): A method of making a business form in accordance with claim 14, including the step of printing indicia on the first side of the liner layer adjacent the integrated tab such that the indicia is exposed when the tab is at least partially removed from the portion.

Claim 18 (Original): A method of making a business form in accordance with claim 14, wherein step of printing indicia on the first side of the liner layer occurs prior to the step of adhesively securing the base layer to the liner layer.

Claim 19 (Original): A method of making a business form in accordance with claim 14, including the step of making a cut-out extending through the base and liner layers adjacent the periphery of the card to assist in removal of the integrated removable portion from the form.

Claim 20 (Original): A method of making a business form in accordance with claim 14, including the step of making a cut-out extending through the base layer adjacent the periphery of the tab to assist in removal of the tab from the integrated removable portion.

Claim 21 (Allowed)

Claim 22 (Previously Presented): A business form having a removable integrated portion, the business form comprising:

- a base layer having a first side and an opposing second side;

- a liner layer having a first side and an opposing second side, the first side of the liner layer being adhesively secured to at least a portion of the second side of the base layer;

- a backing layer having a first side and an opposing second side, the first side being adhesively secured to at least a portion of the second side of the liner layer;

- an integrated removable portion of the form comprising at least a portion of the base layer and the liner layer, the integrated removable portion having a periphery edge substantially defined by a first die cut extending substantially through the base and liner layers so that the backing layer maintains the integrated removable portion in the form against unintentional removal from the form; and

- an integrated tab comprising a portion of the base layer and being surrounded on at least three sides by the integrated removable portion, the tab being at least partially removable from the base layer portion and having a periphery edge substantially defined by a second die cut extending substantially through the base layer so that the liner layer at least partially maintains the tab in the integrated removable portion against unintentional removal from the form; and

- wherein at least a portion of the second side of the base layer coextensive with the integrated tab has a greater affinity for retaining adhesive than the first side of the liner layer.

Claim 23 (Previously Presented): A business form having a removable integrated portion, the business form comprising:

- a base layer having a first side and an opposing second side;

- a liner layer having a first side and an opposing second side, the first side of the liner layer being adhesively secured to at least a portion of the second side of the base layer;

- a backing layer having a first side and an opposing second side, the first side being adhesively secured to at least a portion of the second side of the liner layer;

- an integrated removable portion of the form comprising at least a portion of the base layer and the liner layer, the integrated removable portion having a periphery edge substantially defined by a first die cut extending substantially through the base and liner layers so that the backing layer maintains the integrated removable portion in the form against unintentional removal from the form; and

- an integrated tab comprising a portion of the base layer and being surrounded by the integrated removable portion, the tab being at least partially removable from the base layer portion and having a periphery edge substantially defined by a second die cut extending substantially through the base layer so that the liner layer at least partially maintains the tab in the integrated removable portion against unintentional removal from the form; and

- wherein the tab is partially connected to the integrated removable portion via a hinge.

Claim 24 (Previously Presented): A method of making a business form having a removable integrated portion, the method comprising:

- providing a base layer having a first side and an opposing second side;

- providing a liner layer having a first side and an opposing second side;

- adhesively securing the first side of the liner layer to at least a portion of the second side of the base layer;

- providing a backing layer having a first side and an opposing second side;

adhesively securing the first side of the backing layer to at least a portion of the second side of the liner layer;

making a first die cut extending substantially through the base and liner layers to substantially define a periphery edge of an integrated removable portion;

making a second die cut extending substantially through the base layer and coextensive with the integral removable portion to substantially define a periphery edge of an integrated tab surrounded on at least three sides by the integrated removable portion, the tab being at least partially removable from the integrated removable portion; and

wherein at least a portion of the second side of the base layer coextensive with the integrated tab has a greater affinity for retaining adhesive than the first side of the liner layer.

Claim 25 (Allowed)

Claim 26 (Previously Presented): A business form in accordance with claim 1, wherein the integrated tab is completely surrounded by the integrated removable portion.

Claim 27 (Previously Presented): A method of making a business form in accordance with claim 14, wherein the integrated tab is completely surrounded by the integral removable portion, the tab being at least partially removable from the integrated removable portion.

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IX. EVIDENCE APPENDIX

None.

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X. RELATED PROCEEDINGS APPENDIX

None.

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XI. CONCLUSION

In view of the foregoing discussion, the Applicant respectfully requests reversal of the rejection of the rejected, pending claims.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

Dated: July 21, 2008

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